

10/038,245 filed 10/24/2001

Parce, et al.

Reply to Office Action of September 15, 2004

REMARKS/ARGUMENTS

Claims 75-89 are pending. Claims 80 and 81 have been amended. Claim 84 has been cancelled.

I. Claim Rejections under 35 U.S.C. §112

Claims 87-89 have been rejected under the second paragraph of 35 U.S.C. §112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. As Applicants stated in their request for interference, pending claim 87 corresponds exactly to claim 31 in U.S. Patent No. 6,136,272 ("Weigl '272"). Similarly, pending claims 88 and 89 correspond exactly to claims 32 and 34 of Weigl '272. Since pending claims 87-89 are identical to claims in Weigl '272, the §112 rejection based on the alleged indefiniteness of the pending claims also applies to the corresponding claims in Weigl '272. When claims corresponding to issued patent claims are rejected, and the grounds for rejection also applies to the issued patent claims, the letter including the rejection must be approved by the Technology Center director. MPEP § 2307.02. Since the pending Office Action does not indicate that the rejection was approved by the Technology Center director, Applicants believe that the rejection of claims 87-89 is moot until it is reviewed by the director. That review will determine whether the USPTO's previous approval of those claims should be reversed.

Claims 75-89 were rejected under the first paragraph of 35 U.S.C. §112 as allegedly failing to comply with the written description requirement. The basis for this rejection is that the instant specification does not provide support for the limitation of a bridge channel that is joined to a main flow channel "along [the] bottom of the main flow channel." The Examiner appears to have interpreted the language "along [the] bottom of the flow channel" to require that the bridge channel connect to the main channel through the bottom of the main flow channel. Applicants must respectfully assert, however, that this is too narrow an interpretation of the limitation that the bridge channel is joined to the "bottom" of main flow channel. As a general rule, claims must be given their broadest possible interpretation. See e.g. MPEP §2111. Other applicable rules of claim interpretation are that the scope of a patent claim is not limited to the preferred embodiments shown in the patent specification (see e.g. *Laitram Corp. v.*

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Cambridge Wire Cloth Co., 863 F.2d 855, 1988 U.S. App. LEXIS 16631, 9 U.S.P.Q.2D 1289 (Fed. Cir. 1988), and that words of a claim must be given their "plain meaning" unless they are defined differently in the specification (MPEP § 2111.01). Applicants assert that if pending claims 75-89 are interpreted according to those three rules, then those claims will be broad enough to encompass embodiments disclosed in the instant specification. For example, consider the case where the "bridge" channel 526 in Figure 5 of the instant channel is in the same plane, and is the same depth, as the main channel 510 and the tributary channel 524. In this case, the bottom of the bridge channel (which would be exactly coplanar with the bottom of the main channel) will intersect the main channel along a portion of the bottom of the main channel. To be exact, the intersection between the bridge channel and the main channel will occur along a line on one edge of the bottom of the main channel. In contrast, the intersection between the bridge channel and the main channel in the preferred embodiment in Weigl '272 occurs along an area on the main surface of the bottom of the main channel. Applicants assert the scope of claims 75-89 should not be limited to the preferred embodiment of Weigl '272, and that that the plain language of the limitation that the bridge channel be joined to the "bottom" of main flow channel is worded broadly enough to encompass the case where the main channel and the bridge channel are coplanar and the same depth. Since that case is supported by the instant specification, the instant specification should provide adequate written support for pending claims 75-89.

Claim 79 was also specifically rejected under the first paragraph of 35 U.S.C. §112 as allegedly failing to comply with the written description requirement. The basis for this rejection is essentially the same as the basis for the rejection of claims 75-89. Accordingly, claim 79 should be supported by the instant specification for the same reasons claims 75-89 are supported. Specifically, since bridge channels that are in the same plane as the main flow channel are joined to the "bottom" of the main flow channel along an edge of the "bottom" of the main flow channel, the instant specification discloses embodiments that fall within the language of pending claim 79. Thus the instant specification provides adequate support for pending claim 79.

Claims 80 and 81 were also rejected under the first paragraph of 35 U.S.C. §112 as allegedly failing to comply with the written description requirement because those claims

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recite dimensions outside the range of dimensions disclosed in the instant specification. Applicants have amended claims 80 and 81 so that the maximum dimension recited in those claims is 500 μm , which is a dimension that is specifically recited in the instant specification. Applicants respectfully assert that these amendments do not eliminate the interfering subject matter in the instant Application and Weigl '272.

Claim 84 was also specifically rejected under the first paragraph of 35 U.S.C. §112 as allegedly failing to comply with the written description requirement. Claim 84 has been cancelled, eliminating the basis for this rejection.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance, and that an interference should be declared between the instant application and US Patent No. 6,136,272. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: 